Supreme Court, U.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-1175

WM. T. BURNETT & COMPANY, INC.,
Petitioner,

v.

THE GENERAL TIRE & RUBBER COMPANY,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION

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Resasons for Denying the Writ

Neither the decision below, nor the record, raises the questions presented in the Petition.

Petitioner's cause of action is for damages for "loss of patent rights" allegedly due to Respondent's fraudulent conduct. The District Court granted summary judgment

dismissing the amended complaint on the grounds that principles of *res judicata* and collateral estoppel bar Petitioner from claiming that it was entitled to patent rights under any circumstances, including the fraud complained of. The Court of Appeals affirmed.

Petitioner's "Questions Presented" individually and collectively mischaracterize the posture of this case. They are premised on the erroneous supposition that Respondent's conduct, determined to be technically fraudulent in another and unrelated action to which Petitioner was not a party, was causally related to Petitioner's failure to obtain a patent.

The questions are a mischaracterization because they fail to disclose

(a) that the final decision being applied as *res judicata* is based on undisputed and incontestable facts which bar Petitioner from establishing an essential element of its cause of action.

(b) that the facts of the fraud were wholly unrelated to and could not affect the facts which were the stated basis of the final decision being applied as *res judicata.*

(c) that the fraud occurred in a different proceeding from the one whose final judgment is being applied as *res judicata.*

(d) that alleged fraud could not and did not affect or impair Petitioner's opportunity to establish its rights to a patent.

There is no issue in this case which warrants review by this Court.

Counter-Statement of the Case

Petitioner, Wm. T. Burnett & Co., Inc. (Burnett) seeks damages from Respondent, The General Tire & Rubber Company (General) for Burnett's "loss of patent rights" by reason of an alleged fraud by General. See Burnett's claim for relief in Amended Complaint (RA-1).[1] General's position, sustained by the District Court and the Court of Appeals, is that Burnett could not be damaged because it was never entitled to any patent rights. Such rights did not exist *ab initio* because Burnett did not satisfy the statutory requirement of 35 U.S.C. §102(g) that its employee was the first to make the invention. Burnett still cannot satisfy such requirement.

The facts essential to consideration of the Appellate Court's opinion are set forth below.

On October 20, 1955, General filed application Serial No. 541,823 for a patent directed to an invention, made by its employee, Frost, for making poly*ether* and poly*ester* polyurethane foam using certain blowing agents (RA-3, Box 1)[2]

On April 1, 1959, General filed two separate patent applications in lieu of the original 1955 Frost application. One was directed exclusively to poly*ether* polyurethane foam (Serial No. 803,381); the other was directed exclu-

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[1] "RA" refers to Respondent's Appendix pages included at the end of this brief.

"App." refers to Petitioner's Appendix pages included at the end of the Petition.

[2] RA-3 is a chart submitted during oral argument before the Fourth Circuit Court of Appeals and is included herein as an aid in setting forth the facts.

sively to poly*ester* polyurethane foam (Serial No. 803,380) (RA-3, Boxes 2 and 7).

With respect to the poly*ether* foam application, the Patent Office granted Patent No. 3,072,582 to General on January 8, 1963 (RA-3, Box 3). In subsequent litigation limited to this poly*ether* patent (RA-3, Boxes 4, 5 and 6), the Court found that in 1958-1959, during the *ex parte* prosecution that led to the grant of Patent No. 3,072,582, General had made misleading and false statements and had withheld experimental data indicating that certain blowing agents which had been disclosed in the prior art as being useful to make poly*ester* foam, could also be used to make flexible poly*ether* foam (See 540 F.2d at pp. 607-608).[3] The Third Circuit Court of Appeals, applying equitable principles, held that General's conduct was not such as to invalidate the patent and concluded that under the totality of the circumstances

> ". . . this record requires a denial of enforcement of Patent No. 3,072,582 only to the extent that its claims purport to apply to flexible polyether urethane foams." (540 F.2d 601, 611)

Thus, Patent No. 3,072,582 remained enforceable as to *rigid* poly*ether* foams.

---

[3] See also the District Court opinion below where it found (App. 7a):

> "The crux of the fraud was General's failure to report to the examiner the results of experiments by its employees, which successfully used these [prior art] agents for blowing poly*ether* foam."

For a complete discussion of the "fraud" litigation, which did not involve Burnett, see *In re MultiDistrict Litigation Involving Frost Patent,* 398 F. Supp. 1353 (D. Del. 1975); affirmed in part, reversed in part, 540 F.2d 601 (3 Cir. 1976).

With respect to General's poly*ester* foam application Serial No. 803,380 (RA-3, Box 7), in 1962, the Patent Office placed it in interference with application Serial No. 610,658 that had been filed by Burnett on September 18, 1956 on an invention made by its employee, Klesper. (RA-3, Boxes 10, 11). The issue in the interference was who, as between Burnett's employee Klesper and General's employee, Frost, was the prior inventor of the poly*ester* polyurethane foam invention. On September 12, 1966, after a fully contested proceeding between Burnett and General, the Board of Patent Interferences decided that Frost was the prior inventor (RA-3, Box 9). In reaching its conclusion, the Board applied 35 U.S.C. §102 (g)[4] and found that the evidence established that Frost had conceived the invention and reduced it to practice in 1955, prior to Klesper's asserted date of conception and reduction to practice (RA-12, 15). The Board of Patent Interferences concluded (RA-17):

> "In view of our holding above that Frost has established that he was the first to conceive and the first to reduce the invention to practice it is unnecessary for us to consider . . . the record presented on behalf of Klesper.
>
> For the reasons given above, priority of invention of the count is hereby awarded to Charles B. Frost, the senior party."

---

[4] §102.

> "A person shall be entitled to a patent unless . . .
>
> * * *
>
> (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered . . . the respective dates of conception and reduction to practice of the invention. . . ."

No appeal from the Board's decision having been taken, it stands as a final and binding adjudication on Burnett that Klesper was not the first to make the invention and is not entitled to a patent on the subject matter of the count of the invention.

After priority of invention was awarded to General, Burnett's application Serial No. 610,658 was referred back to the Patent Office Examiner for action in further *ex parte* proceedings. In such proceedings, Burnett had the opportunity to seek a patent on any claims to an invention, or species thereof, which was patentably distinct from the invention defined by the count of the interference. This Burnett application was *denied* (RA-3, Box 12).[5]

ARGUMENT

POINT I

The District Court found and the Appellate Court affirmed that Burnett was never entitled to a patent.

Because Burnett seeks damages for loss of "patent rights", it is clear that if Burnett was never entitled to any patent rights, it cannot prevail in an action for loss of such rights. Thus, the key question before the District Court and the Court of Appeals was whether Burnett was entitled to a patent on the Klesper invention in the first instance.

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[5] In 1964 Burnett also filed application Serial No. 336,038 in which it copied claims of General's poly*ether* patent and attempted to provoke an interference with those claims. In *ex parte* proceedings, its efforts were rejected by the Board of Patent Appeals and the rejection was affirmed by the Court of Customs and Patent Appeals, 158 U.S.P.Q. 256 (RA-3, Boxes 13, 14 and 15).

To be entitled to a patent, one must be the first inventor, 35 U.S.C. §102(g). This principle is fundamental in our patent system. See *Alexander Milburn Co.* v. *Davis-Bournonville Co.*, 270 U.S. 390, 399-402 (1926); *Corona Cord Tire Co.* v. *Dovan Chemical Corp.*, 276 U.S. 358, 384-85 (1928).

In the interference proceeding between the Frost and Klesper applications, the Board of Patent Interferences decided that Klesper was not the first inventor of the poly*ester* foam invention. That decision was based on events occurring prior to September 1955 which established that Frost had conceived the invention and reduced it to practice prior to Klesper's claimed date of invention. See RA-4 for the 1966 opinion of the Board of Patent Interferences conclusively demonstrating that it is based solely on facts occurring in 1955. Burnett's allegation of fraud relates to events occurring in 1958-1959 concerning the operability of certain prior art blowing agents. Even if the alleged fraud had been known to the Board of Patent Interferences, it would not have changed the Board's decision on the issue of priority of invention. As stated in *Standard Oil Company* v. *Montedison, S.p.A.*, 540 F.2d 611, 617 (3 Cir. 1976),

> ". . . it is only fraud which may have affected the determination by the Board of the factual issue of priority of invention, i.e., the question as to which of the parties involved in the interference actually first used the device or process of the invention, which could have any effect on the determination by the Board of that historical fact. While other fraud might well affect the right of the party perpetrating it to receive a patent even though he was in fact the first of the parties to the interference to use the invention, it obviously could not change

the historical fact of priority itself or authorize a finding that another party had priority of invention whose use had actually been anticipated by the first party."

That this was one basis for the District Court decision to grant summary judgment is also clear from its opinion where it stated (App. 7a):

> "Plaintiff [Burnett] cannot now relitigate the issue of priority. This was the very issue litigated between the parties in the interference, and Burnett's time for appeal has long since passed. Whether a fraud directly related to the order of invention would constitute an exception to the principle of res judicata need not be decided, since there is no such issue under the facts of this case. The fraud related to events in 1958 and to the issue of superiority over prior art. It would not have changed the Board decision on priority between Klesper and Frost, based on the level of work each had attained by 1955."

The Court of Appeals also recognized that Burnett's employee, Klesper, was not the first inventor (App. 20a-21a):

> "In the Interference, the PTO, on September 12, 1966, awarded priority to General/Frost, not for the reason that General's application of October 20, 1955 was earlier than Klesper's of September 18, 1956, but because the General/Frost invention was reduced to practice earlier than the Burnett/Klesper one."

Thus, Klesper lost the interference because Frost, not Klesper, was the first inventor. Because Klesper was not

the first to make the invention, under 35 U.S.C. § 102(g), Burnett was not entitled to the grant of a patent on that Klesper invention regardless of the fraud of General. It is in this context that the District Court and the Court of Appeals for the Fourth Circuit held that Burnett's decision not to appeal on the issue of priority of invention foreclosed Burnett from subsequently challenging the decision that Klesper was not the first inventor.

Commissioner v. *Sunnen,* 333 U.S. 591 (1958), cited by Burnett, also supports the grant of summary judgment. *Sunnen* holds (p. 598):

> ". . . the judgment in the prior action operates as an estoppel . . . as to those matters in issue or points controverted, upon the determination of which the finding or verdict was rendered. . . . But matters which were actually litigated and determined in the first proceeding cannot later be relitigated."

Here, the judgment in the prior action, now being applied as *res judicata,* was the decision of the Board of Patent Interferences that Klesper was not the first inventor.[6] That decision was based solely on facts occurring in 1955. The fraud, based on occurrences in 1958-1959, was unrelated to the matters adjudged by the Board of Patent Interferences. As stated by the District Court, the fraud facts

> "would not have changed the Board decision on priority between Klesper and Frost, based on the level of work each had attained by 1955" (App. 7a).

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[6] Burnett, at page 13 of its Petition, concedes this point:

> "In the case at bar the patent examiner's [sic (Board of Patent Interferences)] decision, asserted by General to be *res judicata,* was based *solely* on the issue of priority."

Thus, Burnett's amended complaint was properly dismissed on established principles of *res judicata* and collateral estoppel which bar Burnett from relitigating the issue of priority. Because Burnett is barred from proving that Klesper was the first to make the invention, it cannot establish that it was entitled to a patent and therefore cannot establish that it lost "patent rights."

Burnett's disability to prove that its employee was the first to make the invention is dispositive of its cause of action. Burnett's amended complaint was properly dismissed.

POINT II

The alleged fraud could not have affected Burnett's opportunity to convince the Patent Office that Burnett was entitled to a patent.

The questions which Burnett presents to the Court improperly suggest that the principle of *res judicata* was applied by the District Court and the Fourth Circuit to sustain a judgment obtained by fraud. This is simply not supported by the record.

The tribunal whose 1966 judgment is being applied as *res judicata* was the Board of Patent Interferences acting in an *inter partes* proceeding. The "tribunal", in which the fraud was practiced was an examiner acting in a different *ex parte* Patent Office proceeding.

The subject of the 1966 Board of Patent Interferences decision was who was the first to make the poly*ester* invention. The subject of the proceeding where the fraud took place was whether General's poly*ether* invention was obvious over the prior art.

The decision of the Board of Patent Interferences was limited to the issue of priority of invention and was based on occurrences in 1955. The 1958-1959 fraud was unrelated to priority of invention.

No matter how one views General's statements concerning operability of certain prior art blowing agents to make flexible poly*ether* polyurethane foam in its *ex parte* proceedings, the interference was an *inter partes* proceeding in which Burnett had a copy of the entire file of General's *ex parte* prosecution of its patent applications. Thus, Burnett had full opportunity to challenge any statements made by General. In addition, Burnett had the opportunity, if it so desired, to submit its own evidence in interference proceeding to show that such prior art agents were operable.[7] Indeed, Burnett had a second opportunity to present evidence in its own behalf when, after losing on the issue of priority, its application Serial No. 610,658 was returned to the examiner for resumption of *ex parte* prosecution (RA-3, Box 12). Burnett had the opportunity to present additional claims to a patentably distinct invention if it believed it had a basis for so claiming. *Application of Taub,* 348 F.2d 556, 560-561 (C.C.P.A. 1965). Being an *ex parte* proceeding, Burnett's efforts to prove its contentions could not have been impeded or affected in any way by General. The outcome of such efforts would have depended solely on the quality and character of the evidence submitted by Burnett to the Patent Office. Burnett's *ex parte* efforts failed.

---

[7] The District Court noted a possible dilemma for Burnett (App. 7a):

> "If the undisclosed experiments would have led the patent examiner to conclude that the Frost application was not superior to prior art, it appears logical that the same reasoning would have made Klesper's work unpatentable."

The essential point is that Burnett had ample opportunity both in the interference proceeding and in its own subsequent *ex parte* proceedings to submit any evidence it chose to establish its right to a patent. If Burnett was dissatisfied with the decisions, it was entitled to appeal for relief to the Court of Customs and Patent Appeals (35 U.S.C. §141) or the District Court (35 U.S.C. §145). The record is barren of such activity.

Having failed to convince the Patent Office of the merits of its position in 1966, Burnett has now, eleven years later, seized upon the Third Circuit decision as to fraud as a basis for attempting to relitigate the issue of priority of invention. However, established principles of *res judicata* and collateral estoppel bar Burnett from relitigating this issue.

Disposition of this case by summary judgment is well grounded and was aptly put by the District Court (App. 16a-17a):

> "As stated, the Board determined that Frost reduced the invention to practice before the first filing date. Therefore, even if the application had been stricken, General would still have had priority, despite losing the benefit of the earlier filing date, 35 U.S.C. §106(g). (sic)
>
> In summary, viewed from any perspective, plaintiff cannot claim for loss of patent rights as a result of the fraud and is not entitled to damages. If the fraud had been brought to light earlier, if General's application had been stricken, if General's claims were unpatentable, plaintiff would not have had priority."

There is no genuine issue for trial and there is no reason to grant this writ for certiorari.

CONCLUSION

The questions presented for review are not supported by the record.

The District Court granted General's motion for summary judgment. (454 F. Supp. 794) (App. 1a). The United States Court of Appeals for the Fourth Circuit affirmed the decision below (203 U.S.P.Q. 801) (App. 18a). Burnett's "Petition for Rehearing by the Court of Appeals for the Fourth Circuit" was denied (App. 23a). Burnett's motion for en banc review of the denial of plaintiff-appellant's petition for rehearing by the Court of Appeals for the Fourth Circuit was denied (App. 24a).

There is no showing that the decision of the Fourth Circuit is erroneous. There is no reason to grant this Petition.

Dated: April 23, 1980

Respectfully submitted,

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APPENDIX

Excerpts from Burnett's Amended Complaint (Civil Action No. Y77-540)

* * *

WHEREFORE, plaintiff prays for judgment against defendant as follows:

(A) That plaintiff be awarded damages arising out of the loss of a patent or patents containing claims of the type allowed in Klesper application Serial No. 610,658 filed September 18, 1956, based upon a reasonable royalty on the patent or patents which would have issued to plaintiff but for the fraud of defendant.

(B) That plaintiff be awarded Five Million ($5,000,000.00) Dollars in compensatory damages for defendant's fraudulent conduct before the United States Patent Office, directly causing damage to plaintiff;

(C) That plaintiff be awarded Five Million ($5,000,000.00) Dollars in punitive damages for defendant's fraudulent conduct before the United States Patent Office, directly causing damage to plaintiff;

(D) That plaintiff be awarded costs of this action and attorneys fees; and

(E) That plaintiff be awarded such other relief as may be just and appropriate in the circumstances.

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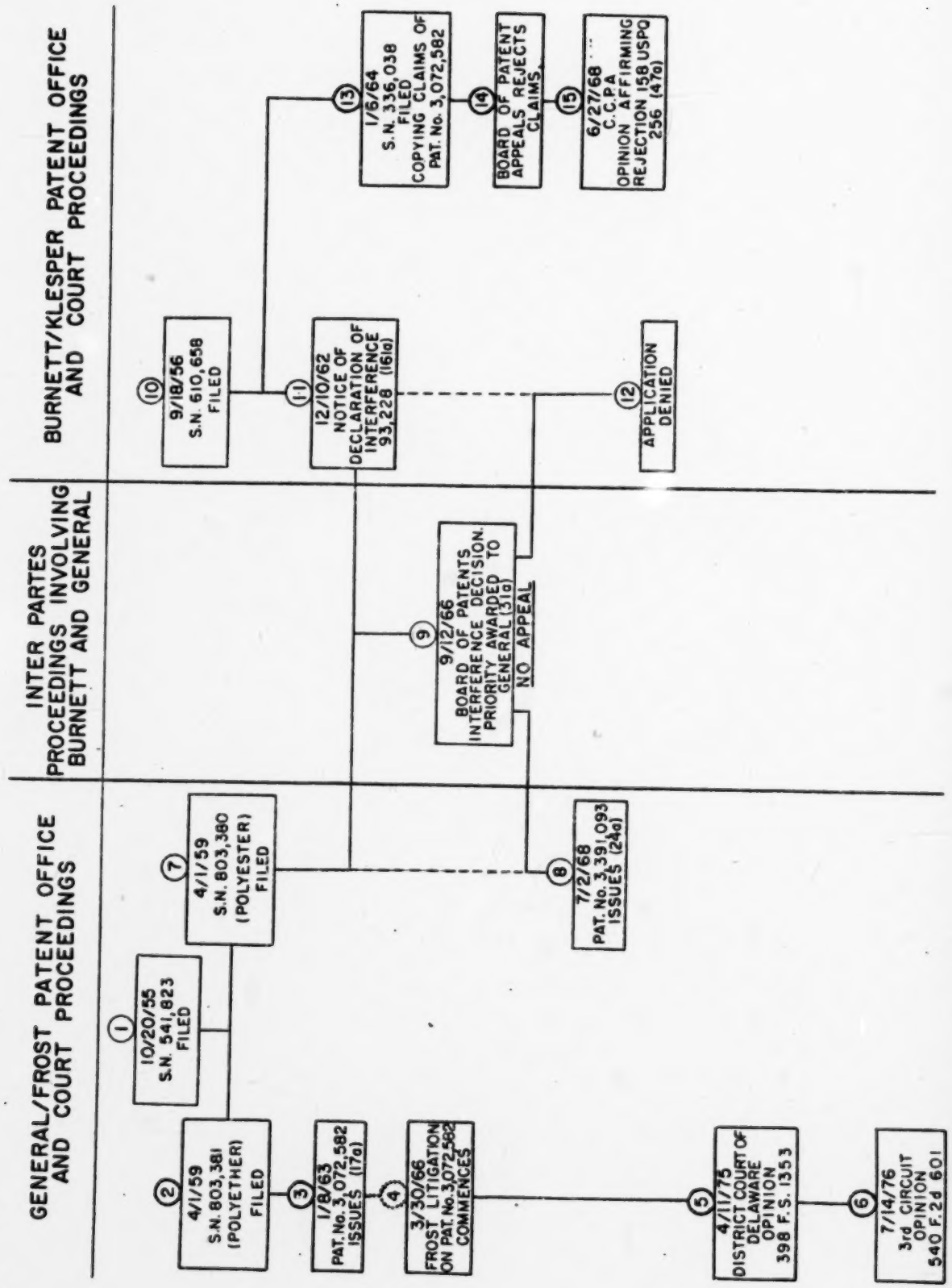
Diagram

[PHOTOSTAT]

(Opposite) ☛


GENERAL/FROST PATENT OFFICE AND COURT PROCEEDINGS
INTER PARTES PROCEEDINGS INVOLVING BURNETT AND GENERAL
BURNETT/KLESPER PATENT OFFICE AND COURT PROCEEDINGS
1 10/20/55 S.N. 541,823 FILED
2 4/1/59 S.N. 803,381 (POLYETHER) FILED
3 1/8/63 PAT. No. 3,072,582 ISSUES (17a)
4 3/30/66 FROST LITIGATION ON PAT. No. 3,072,582 COMMENCES
5 4/11/75 DISTRICT COURT OF DELAWARE OPINION 398 F.S. 1353
6 7/14/76 3rd CIRCUIT OPINION 540 F.2d 601
7 4/1/59 S.N. 803,380 (POLYESTER) FILED
8 7/2/68 PAT. No. 3,391,093 ISSUES (24a)
9 9/12/66 BOARD OF PATENTS INTERFERENCE DECISION. PRIORITY AWARDED TO GENERAL (31a) NO APPEAL
10 9/18/56 S.N. 610,658 FILED
11 12/10/62 NOTICE OF DECLARATION OF INTERFERENCE 93,228 (16a)
12 APPLICATION DENIED
13 1/6/64 S.N. 336,038 FILED COPYING CLAIMS OF PAT. No. 3,072,582
14 BOARD OF PATENT APPEALS REJECTS CLAIMS
15 6/27/68 C.C.P.A. OPINION AFFIRMING REJECTION 158 USPQ 256 (47a)

Opinion of the United States Patent Office
Board of Patent Interferences

Final Hearing
March 17, 1966

Paper No. 87
JSB/dlr

IN THE UNITED PATENT OFFICE

BEFORE THE BOARD OF PATENT INTERFERENCES

Patent Interference No. 93,228

Klesper v. Frost

Polyurethane Foams, Compositions and Methods

Application of Ernst F. G. Klesper filed September 18, 1956, No. 610,658

Application of Charles Bedell Frost filed April 1, 1959, No. 803,380 accorded benefit of Ser. No. 541,823 filed October 20, 1955

Mr. Sol Shappirio and Messrs. Balwin, Wight, Diller and Brown for Klesper

Messrs. McCoy, Green and TeGrotenhuis, Mr. F. J. Earnheart, Mr. D. S. Matthews and Mr. W. T. Black Frost

---

Boys, Bailey and Gaston, Examiners of Interferences

Opinion of the United States Patent Office
Board of Patent Interferences

Bailey, Examiner of Interferences

This interference involves a method of producing a polyurethane foam which is adequately described in the count which reads as follows:

Count 2

A method of producing a polyurethane foam which comprises mixing:

1) An organic polyisocyanate;

2) a polyester which is a reaction

product of components comprising a dihydric alcohol and a dicarboxylic acid;

3) water; and

4) a chlorofluoro-alkane; said alkane

being volatilized during the foaming reaction between components (1), (2) and (3).

The present count was substituted for the original count on the Examiner's own motion so that a polyester resin prepared from trihydric alcohols would be included, see Examiner's "Decision on Petition from (sic) Reconsideration," paper No. 28, pages 5 and 6. Frost is the senior party by virtue of the fact that he was granted the benefit of the filing date (October 20, 1955) of his prior application, Serial No. 541,823, by the Examiner (see Decision on Motions of January 14, 1964, Paper No. 22).

Both parties filed briefs and were represented at final hearing. Klesper carries the burden of proving priority

by the preponderance of the evidence. The parties in interest are William T. Burnett & Co. and The General Tire & Rubber Co., assignees of Klesper and Frost respectively.

Both parties have presented priority testimony together with documentary and other exhibits. In view of the fact that the earliest activity relied upon is that alleged by Frost, we shall first consider the record presented on his behalf. In our discussion Frost's record will be referred to as F. R. followed by page number, and Klesper's record will be designated K. R. and page number.

It appears from the record that the assignee of the Frost application in 1954 sent a team which included Frost and Sanger with others to "Bayer" in Germany to obtain "complete know-how" of the polyurethane foam process and the equipment which had been developed there. This team brought back from Germany certain formulations, as well as components to be used for preparation of polyurethane foams. It also appears that on their return from Germany Frost and his co-workers set up the machine which had been purchased there and set about getting it into operation to produce polyurethane foam. A polyester known as "Desmophen 2200", toluene diisocyanate, catalyst and certain other components were used in the preparation of the foam. Frost Exhibit 1 contains a listing of formulations that were obtained in Germany.

Frost testified (F. R. 22-26) that he found that foams prepared from the above formulations appeared to be somewhat stiff, and to have undesirable load-deflection behavior. Frost testified further that a change was made

in the formulation which involved the incorporation of a liquidied gas into the system. Frost Exhibit 2 is a copy of a memorandum addressed to T. E. Pittenger, who appears to have been in the legal department at General Tire & Rubber Company. This memorandum, dated January 31, 1955 describes the dispersing or dissolving duPont "Freons", or General Chemical "Genetrons" in the polyurethane mixes for the purpose of aiding in the expansion of the foam. It is also stated therein that the use of such liquidied gas decreases the amount of isocyanate required and that "it was found that the foams produced with the Freons were very much softer than those made in the normal way." The memorandum specifically mentions Freon-12 (dichlorodifluoromethane) and Freon-22 (difluoromonochloromethane) that had been used in experiments.

Exhibit 2-A is a Ditto master of another memorandum addressed to Pittenger, and dated February 1, 1955, which Frost testified is the master of a memorandum prepared by him. This memorandum also refers to the use of Freon-12 and Freon-22 in the preparation of polyester-diisocyanate foams and states that the liquified gas is vaporized and is an expansion gas source. Lea, a laboratory technician who worked for Frost at the time, testified (R. 1667) that he signed Exhibits 2 and 2A as a witness on February 10 and 9, 1955 respectively.

Frost Exhibits 5-A through 5-FF are described by Frost as notes on experimental runs on various dates in February and March 1955 involving the use of Freon-12 and Freon-22 in the preparation of foams from polyester-diisocyanate compositions. Frost testified (F. R. 245) that after the experiments reported in Exhibits 5-A to

5-FF the process (including the use of Freons and Genetrons) was transferred to the production polyurethane foam unit at Marion, Indiana. The machine there was one shipped from Germany and Frost testified that on March 28-31, 1955 he prepared polyurethane foam containing Genetron 141 or Freon-22 at Marion. Frost Exhibit 8 is a written report from Frost to G. H. Swart, who was Director of Research, describing the above experiments and including certain "Experimental Batch" sheets which include formulations, "Notes on Operation" and certain "Physical Test Data." Frost Exhibit 9 is a typed copy of this report, which bears a date of April 4, 1955. Swart testified (F. R. 1427-1429) that he had seen Exhibit 9 (or a copy thereof) about the time it was prepared and that he had followed this program very closely.

Maxey, a witness on behalf of Frost, testified that he came to the Research Division of the General Tire & Rubber Company on February 1, 1955 and was assigned to Sanger's group (to which Frost was assigned), working on the development of polyurethane foams. Maxey stated (R. 920) that "one of the first things they told me about it was their use of fluorocarbons for blowing, as auxiliary blowing agents for foam." Maxey further testified that Frost explained the operation of the foam machine and "how the foams were run." With respect to the use of fluorocarbons Maxey testified (F. R. 921):

> Q16 When did you learn about the use of fluorocarbons in foam?
>
> A This was one of the first things that was told to me on my first day of employment. The reason was that Merle, Frost, and everybody connected with foam research and development felt that this

> was a really significant break-through and they were very excited about it and they wanted me to know about it very early.

Maxey testified that he ran the foam machine and produced foams which included fluorocarbons (as well as those which were "direct-water blown" foams) and was assisted by Cole and Lea. Maxey also testified that he had assisted Frost in making a production run of Freon blown foam at Marion (F. R. 945).

It appears from the record that most of Maxey's work on polyurethane foams was carried out at the research laboratories of General Tire & Rubber at Akron, Ohio. Maxey testified (F. R. 924) that his first use of fluorohydrocarbons in the formation of polyurethane foam was on April 25, 1955. The record shows that Maxey worked out different formulations including Freon, or Genetron, in the laboratory "and then in conjunction with the development people at Marion." (F. R. 938). Experiments run by Maxey were recorded in notebooks kept by Lea and Cole, his technicians, which runs were identified by "E-" followed by a number (F. R. 950, 954, 959 and 1340).

Maxey also testified that samples of foams produced including Freon were taken or sent by him to the Physical Test Laboratory to have certain tests run. Included among the tests run was a compression set test. The record includes the orders for, and the sheets showing the results of these tests. Elsie Lowery and Phyllis Black who ran some of the tests and recorded the results thereof testified on behalf of Frost. The record shows that Maxey's experiments involving the use of Freon in the preparation of polyurethane foams extends from April into August of 1955.

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The record shows that on June 2, 1955 Heberling, an attorney with the firm of McCoy, Greene and TeGrotenhuis, requested permission to file an application on the process of utilizing duPont Freons as a source of gas required to make polyester-diisocyanates foams (Frost Exhibit 50) and that on June 27, 1955 the first draft (Exhibit 56) of an application disclosing this process was prepared. This application eventually became Frost's above mentioned parent application filed October 20, 1955.

It is urged by Frost that he has established that he was first to conceive the invention and the first to reduce it to practice. Frost also urges that he was diligent from his conception until either an actual or constructive reduction to practice.

Klesper has raised a question as to the use of chlorofluoro-alkanes which have low boiling points and are not liquid at ordinary room temperature and atmospheric pressure. It is Klesper's contention that the count requires such liquid chlorofluoro-alkane. It is urged that the use of Freon-12 and Freon-22 as disclosed in the Frost parent application does not support the count and that Frost should not have been granted the benefit of the filing date of his parent application (Serial No. 541,823). As we shall point out below, we are of the view that Frost has established an actual reduction to practice prior to the filing date of his parent application, so that it is not essential to our decision that Frost be accorded the benefit of the filing date of this application. However, we cannot agree with this contention of Klesper and are of the opinion that Frost was properly made the senior party.

The Frost parent application clearly discloses that an easily liquified gas, such as halogen-substituted alkanes,

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may be used as a source of gas for the expansion of the polyurethane into a foam. It is stated therein that the liquified gas is dispersed or dissolved in the polyester employed. On pages 5 and 6 of that application it is stated that if the liquified gas used is one that is soluble in the polyester the boiling point thereof can be much lower than —10°F, and can be as low as —60°F. Freon-22 is disclosed in Example 2 as being a soluble gas which can be used for Frost's purpose. We are of the view that a process wherein the chlorofluoro-alkane is volatilized (during the foaming reaction) from a solution or liquid dispersion thereof is clearly within the scope of the count. All that is required in this respect is that the chlorofluoro-alkane be volatilized "during the foaming operation." This is certainly taught in the Frost application Serial Number 541,823.

As pointed out above, Frost Exhibits 2 and 2A disclose a process in which Freon-12 or Freon-22 is used as a gas expansion source in the production of polyester-diisocyanate foam. Maxey testified that he was told of Frost's work involving the use of Freons in the manufacture of polyester-diisocyanate foams shortly after February 1, 1955. Frost Exhibit 9, which is a report prepared by Frost dated April 20, 1955 describes the production of such foams including Genetron 141 (difluoromonochloromethane). Sanger, Frost's supervisor, as well as Kielich, the manager of development and production of foam products at the Marion plant, testified that they saw this report at about the time it was prepared (F. R. 857 and 1560). Heberling testified (F. R. 1211-1214) that both Exhibits 2 and 9 had been used by him in the preparation of the Frost parent application. Exhibit 56, which was the first draft of this

parent application describing the process of employing Freons in the preparation of polyester-diisocyanate foams was prepared by Heberling on June 27, 1955.

We note that the earliest date alleged by Klesper in his preliminary statement is "in July 1955". Thus, whether Frost is accorded as a date for conception of February 9 or 10, 1955, when Exhibits 2 and 2A were witnessed by Lea or as late as June 27, 1955 when the first rough draft of the parent Frost application was prepared by Heberling, the date of conception is prior to any date alleged by Klesper. Klesper in his briefs at final hearing has not challenged the contention by Frost that he was the first to conceive the invention in issue. We hold that the record as outlined above is sufficient to establish that Frost was the first to conceive.

We turn now to the asserted reduction to practice on behalf of Frost. Frost relies on certain experiments that he carried out recorded in Exhibits 5A through 5FF. These experiments appear to have been carried out in the period of February and March 1955. Frost, in his testimony has referred specifically to runs 252 through 266 recorded on Exhibits 5U through 5EE which were carried out on various dates in March 1955. The testimony of Lea is relied upon as corroboration of these experiments.

Benson, who was in charge of the machine operators at Marion, testified (F. R. 765-776) that in March of 1955 he was working "in urethane foams" and that he worked with Frost in preparing foams from polyesters, diisocyanate and Genetron 141 on the machine at Marion. Benson testified that matresses were made from this foam

which was softer than the foam first run. Benson also testified (F. R. 777) that every batch of foam run had a batch sheet made out for it before it was run and that Frost was the one who kept the records of the batch sheets. Benson identified page 11 of Frost Exhibit 8 as being a batch sheet the upper half of which was prepared by Frost in his presence. This sheet indicates that the batch included 5% Genetron 141. Benson also testified (F. R. 792-798) as to having seen Frost prepare the top half of Batch sheets 1290 to 1295 (Exhibit 8) and having assisted Frost in the preparation of the foam from those formulations. It appears that the data on the bottom half of the batch sheets was that obtained from certain physical tests that were performed on the foam after it was made.

Kielich, also testified to seeing Frost prepare a foam from a mix including polyester resin, diisocyanate and Genetron, 141 in March 1955 (F. R. 1550-1557). Kielich also identified the batch sheets of Exhibit 8 as those used at Marion during Frost's work and stated (F. R. 1562) that he collaborated with Frost "with the incorporation of some of the format of the batch sheets." Kielich further testified (F. R. 1558-1561) that after the initial work of Frost on foams containing Genetron or Freon "it was put into production procedure."

As pointed out above, the record shows that Maxey carried out a number of experiments wherein Freon was employed in the production of polyurethane foams. Maxey also testified (F. R. 938) as to working out production formulations used at Marion. Lea testified (F. R. 1671-1673) that Exhibit 32 was a notebook issued to him and identified certain notes made therein as records of runs

made when he was working for Maxey. These notes refer to runs numbered E-36 to E-102 inclusive and bear various dates in May and June 1955. A number of the runs included Freon in the formulations. Cole testified (F. R. 1811-1816) that he was present when the experiments recorded on Exhibit 32 were run. Cole also testified (F. R. 1801-1804) that he assisted Frost in preparing foams from mixes including Freon or Genetron, polyester and diisocyanate probably in the Fall of 1954 shortly after coming to work with Frost.

Schick, a trainee, testified that he spent time at Marion and in the Research Department in Akron learning about polyurethane foam and that he saw such foam produced with Freon-22 during the period of July 26 through August 8, 1955 (F. R. 1929-1936) and that he kept notes which he intended to take with him when he went to Venezuela. Schick also stated that he actually ran the second shift on production and had made foams with some of the formulas shown in Exhibit 90A, and could definitely recollect formula two-eighteen soft shown thereon.

Exhibits 23A, 23B, 29, 30, 33, 44, 77 to 84, 86, 87, 88, 92 and 93 include records of certain tests ran on foams prepared at General Tire and Rubber by Frost and others. Elsie Lowery and Phyllis Black identified those reports and testified that they included data recorded in their respective handwriting and resulted from work done by them.

As pointed out above, Maxey produced polyurethane foams from polyester, a diisocyanate, and a Freon after being informed of Frost's work. One such preparation of such a foam is recorded in Exhibit 32 (page 72) as run E-99 carried out June 8, 1955. Lea testified (F. R. 1671-1673) that he made those entries and prepared the foams for Maxey, for whom he was working. Frost Exhibit 30 dated 8/10/55 shows the results of certain tests run on foam E-99. Lowery testified (F. R. 2003, 2030) that she recorded the data shown on the second page and had run the tests shown. Maxey and Lea also testified as to run E-175 as a run, employing Genetron, in which a "hydrophilic foam designed for use in household sponges" was produced. (see particularly F. R. 954-959). Exhibit 45 is a notebook record of this run in Lea's handwriting and Lea testified as to having made the tests shown on page 19 thereof on or about July 25, 1955. Frost Exhibit 86 shown results of certain other tests run on or about July 27, 1955 on foam E-175. Maxey also testified specifically as to runs E-37 and E-38 which are recorded on page 47 of Exhibit 32 (F. R. 962-965) which were run by Lea on May 19, 1955 under Maxey's direction. Exhibit 33 includes data of compression set tests run on foams E-37 and E-38 May 24, 1955. These tests appear to show that these foams possess the desired softness.

We are of the view that the record clearly establishes that the invention in issue was reduced to practice on Frost's behalf prior to the date of reduction to practice alleged by Klesper in his preliminary statement (September 1955). Experiments were run by Frost and by Maxey in which Freons and Genetrons were used. The above runs E-175, E-99, E-37 and E-38 are examples of foams prepared by Maxey (not an inventor) and tested prior to Klesper's alleged reduction to practice. As pointed out above, Sanger, Benson, Maxey, Kielich, Lea and Schick had direct knowledge of Frost's preparation of foams from polyester, diisocyanate and chlorofluoro-alkane and had observed Frost prepare such foams. The record shows that

at least some of these foams were successfully tested. For the reasons given above, it is our conclusion that processes utilizing Freon-12 or Freon-22 fully satisfy the terms of the count.

The record shows that based on his work Frost in April 20, 1955 prepared a report (Exhibits 8 and 9) with a view of putting the process into production. Prompt steps were taken to file a patent application directed to this process. We are of the opinion that the record clearly establishes that Frost and his assignee The General Tire & Rubber Company were convinced of the success of the process.

Klesper urges that the testimony of certain of the witnesses for Frost is unreliable for various reasons. Our overall consideration of the record presented by Frost convinces us that a reduction to practice on Frost's behalf prior to Klesper's assorted reduction to practice has been established. As pointed out in Mann v. Werner *et al.*, 52 CCPA 1578, 146 USPQ 199, 1965 CD 919, 820 O.G. 1747, it is not necessary that each individual act in the reduction to practice of a count must be proved in detail by an unbroken chain of corroboration. That case holds that the proper approach involves a reasoned examination, analysis and evaluation of all the pertinent evidence bearing on the question, to the end that a reasoned determination as to the credibility of the inventor's story may be reached. Such approach in this case leads us to the conclusion given above. See also Patterson *et al.* v. Hauck, 52 CCPA 987, 144 USPQ 481, 1965 CD 212, 814 OG 1101.

In arriving at our conclusion we have given no consideration to the experiments performed on behalf of Frost in 1965, after the declaration of interference.

Klesper in his principal brief, on pages 4 to 9 raises the question of double patenting as to Frost. This question is not ancillary to the question of priority and cannot be considered by us at final hearing, Darby *et al.* v. Whitworth, 20 CCPA 791, 1933 CD 135, 16 USPQ 85, 65 F 2d 368.

Klesper also urges that the evidence adduced in the testimony and exhibits shows that not all chlorofluoro-alkanes are operative and hence the count is too broad. In his reply brief Klesper has referred specifically to certain testimony of Frost. Klesper requests that we make a recommendation under Rule 259. Such recommendations are discretionary with this Board. Questions of the breadth or scope of the count are not ancillary to priority, Fried *et al.* v. Murray *et al.*, 46 CCPA 914, 746 O.G. 563, 122 USPQ 361, at 363. Under the circumstances of this case we decline to make a recommendation under Rule 259.

In view of our holding above that Frost has established that he was the first to conceive and the first to reduce the invention to practice it is unnecessary for us to consider the question of diligence on the part of Frost or to consider the record presented on behalf of Klesper.

For the reasons given above priority of invention of the count is hereby awarded to Charles B. Frost, the senior party.

Board of Patent Interferences

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